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09/964,661	09/28/2001	Seigo Murakami	2001-1478A	3534
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WENDEROTH, LIND & PONACK, L.L.P.				
2033 K STREET N. W.				
SUITE 800				
WASHINGTON, DC 20006-1021				
EXAMINER				
CHIN, RANDALL E				
ART UNIT		PAPER NUMBER		
1744				

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/964,661

Applicant(s)

MURAKAMI ET AL.

Examiner

Randall Chin

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 9-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.
2. Applicant's election of Group I, claims 1-8 in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Mihara '273.

The patent to Mihara '273 discloses a cylindrical cleaning element defined by a cleaning sponge roller 1 having an axial through-hole (Fig. 1a) formed therein, a rotating axis or rotary shaft 7 in the through-hole with a friction-type fit or "press-fit", and since the cylindrical cleaning element is made of polyvinyl acetal (PVAc as recited in col. 4,

lines 1-7), it is capable of being in either a wet state or a dry state, wherein the through-hole of the cylindrical cleaning element in a wet state has a diameter smaller than a shaft diameter of the rotary shaft and capable of being enlarged, and the cylindrical cleaning element in a dry state is capable of being set in a form such that the through-hole is enlarged. With respect to the recitation in claim 4 reciting that the press fit of the rotary shaft in the through-hole of the cylindrical cleaning element is performed when the cylindrical cleaning element is in a wet state, it is the Examiner's position that such a recitation is drawn to the step or method of making the device and is not germane to patentability here in apparatus claims.

With respect to claims 3 and 7 reciting that the cylindrical cleaning element is made in the dry state with the through-hole enlarged and, before being made in the dry state, the cylindrical cleaning element is subjected to the wet state to enable the through-hole to be enlarged and purified in the wet state, as stated previously, it is the Examiner's position that such a recitation is drawn to the step or method of making the device and is not germane to patentability here in apparatus claims.

As for claim 5, each of the rotary shaft and the through-hole has a circular cross-section (Fig. 4).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mihara '273 in view of Perna '711.

Mihara '273 discloses all of the recited subject matter as previously set forth above with the exception a surface of the rotary shaft being formed so as to include raised and recessed portions for preventing a sliding motion. Perna '711 teaches a surface 2 of a rotary shaft1 being formed so as to include raised and recessed portions (or knurls) for preventing a sliding motion (see Abstract, col. 2, lines 17-20 and col. 3, lines 64-66). It would have been obvious to one of ordinary skill in the art to have provided Mihara's rotary shaft with raised and recessed portions as suggested by Perna '711 for preventing a sliding motion or slippage between the cleaning element and shaft.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Horeni teaches a knurled arrangement for a shaft and Tomita, Andros, and Cerpone teach sponge roller arrangements.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Chin whose telephone number is (703) 308-1613. The examiner can normally be reached on Monday through Thursday and every other Friday.

**A scheduled move is set for December 16-17, 2003 and the Examiner can then be reached at new telephone number (571) 272-1270.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Warden can be reached on (703) 308-2920. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



R. Chin



Randall Chin  
Primary Examiner  
Art Unit 1744